application can be made without serious burden, the examiner **MUST** examine it on the merits, even though it includes claims to independent or distinct invention." (MPEP §803, emphasis added.) Applicants respectfully point out that Claims 1-13 (Group I) are drawn to a method of assaying for the presence of an enzyme where the product of that enzyme may be phosphorylated or dephosphorylated (*e.g.*, the enzyme being assayed is either a kinase or a phosphatase); the same is true of Claims 14-30 (Group II) and Claims 31-46 (Group III). All three of these claim groups, therefore, are classified within the same search class and sub-class (presumably class 435, subclass 194). Therefore, there can be no additional burden on the Office if all three of Groups I, II, and III are searched and examined simultaneously because the search effort for all three groups of claims is co-extensive. A proper search for the invention recited in the claims of Group III will necessarily reveal the inventions recited in the claims of Groups I and II.

Applicants therefore submit that the rejection between the claims of Groups I, II, and III is improper and should be withdrawn.

The Office has characterized the relationship between Groups I-III and IV as process and apparatus for its practice. Citing MPEP §806.05(e), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that the process as claimed can be practiced by another, materially different apparatus or by hand; or (2) that the apparatus as claimed can be used to practice another and materially different process. The Examiner goes on to state that, in the present application, the process can be carried out without the kit, *i.e.*, by hand. Applicant submits that the reason offered by the Examiner is insufficient to support a conclusion of patentable distinctness between the restricted claims. The Examiner has provided no indication as to how performing the process "by hand" is materially different from using the claimed kit to perform the process, in which case the process is arguably carried "by hand" in any event.

Moreover, **as claimed**, Claim 47 explicitly recites a kit "for assaying the presence, activity, or both of an enzyme..," using language that mirrors the process

claims. In short, the kit as claimed is specifically designed to carry out the process of Groups I, II, and III. If the kit were used otherwise, it would not be the same kit as claimed.

Accordingly, because the Office has not carried the burden of providing technologically sound reasons or examples for concluding that the claims of the restricted groups are patentably distinct, the restriction requirement between Groups I-III and Group IV is improper and should be withdrawn.

ELECTION OF SPECIES

Applicants traverse the election of species requirement because the Office has made no attempt to show, by way of reasons or examples, how the species identified by the Examiner are patentably distinct. In the same fashion as a restriction requirement, the MPEP requires that the Office advance some objective reasoning as to why the identified species are patentably distinct. This has not been done in the present Office Action. The Office has simply identified mutually exclusive species and concluded, without any supporting commentary, that the species are patentably distinct. Applicants therefore traverse the election of species requirement because the mere identification of mutually exclusive species is not sufficient to support an election of species requirement.

Applicants further note that, with the provisional election of a single species, should no prior art be found that anticipates or renders obvious the elected species, the search of the claims will be extended to the other, non-elected species. MPEP §803.02.

CONCLUSION

Applicants submit that the application is now ready for examination on the merits. Early notification of such action is earnestly solicited.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. Serial No.: 09/871,424 Group Art Unit: 1627

Filing Date: 05/31/2001 Examiner: Guo, Lynda

Applicants: Goueli et al Attorney Docket No.: 34506.1

Title: ASSAY FOR KINASES AND PHOSPHATASES

"MARKED UP" PARAGRAPHS AS AMENDED, 37 CFR §1.121(b)(1)(iii)

Addressing the present invention first, the most immediate advantage is that the lipids do not have to be dried from an organic **[sovent]** **solvent**. Instead, the reaction solution is simply spotted directly onto the binding matrix. The enzyme is added to the bound substrate and the reaction run for a specified period of time. The reaction is then stopped, the membrane is rinsed, and the amount of label retained on the matrix is measured.